

REMARKS

Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the amendments and discussion that follows. Claims 1-58 are pending in the prior application.

Claims Objections

With regard to claims 4 and 32, the Examiner asserts that "even if advertiser may indicate that his ads may be printed in a physical ad-book, the system is operable, however, to disable this function, especially since the advertisements are primarily viewed on line or over the Internet" (Office Action of 6/30/06, page 2). However, a review of the specification fails to provide any support for the Examiner's statements. For example, the statement that "ad-books may not be printed in physical form" (specification, page 10, lines 14-15) merely indicates that that the ad-books may or may not be printed, when advertisements are viewed from user terminals. Nowhere within the specification is there any support for the assertion that "the system is operable . . . to disable this feature." Since there is no support for this assertion, the objection is not well founded. Since the objection is not well founded, it is improper and should be withdrawn.

With regard to claims 28 and 50, the Examiner objects to the use of the word "such" in the preamble. In response, claims 28 and 50 have been amended to replace "such" with "the."

Rejections Under 35 U.S.C. §102(e)

Claims 1-9, 12-15, 16-37, 40-49 and 50-58 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. Appl. No. US 2002/0188532 to Rothstein. The applicant respectfully traverses these rejections.

In response, independent claims 1, 28, 29 and 50 have also been further limited to "computerized/automated preparation, production, publishing and management of "ad-books" and related print or publishing used by or for organizations for charity or fund raising, whereby organizations, members and/or supporters of the organization place or manage "ads" or messages in the organization's publication." Support for the further limitations may be found in the specification on page 1, lines 7-8, lines 11-12 and lines 17-18.

Independent claims 1, 28, 29 and 50 have also been further limited to the context "where the "ad-book" or related print publication is a fundraising vehicle and the organizations, members or supporters of the organization solicit for or place the ads or messages to make contributions to the organization." Support for this further limitation may be found within the specification on page 1, lines 17-18 and lines 25-27.

The claimed invention now differs from Rothstein at least in the context and use of the invention. For example, "Organizations that may use ad-books include charities, schools, teams, associations, clubs, professional organizations, lodges, unions, boards, fraternities, sisterhoods, causes, hospitals, homes, condo-boards, synagogues, events, community groups, and political party candidates" (specification, page 1, first full

paragraph). As such, ad-books are clearly not used to sell a particular product or products.

On page 1, lines 25-26 of the specification, the term "advertiser" is shown with quotation marks to show that "advertiser" is not meant in the sense of commercial advantage. In order to highlight this special meaning, "advertiser" has been replaced by "ad" to further clarify this special meaning.

In addition, "Often ad-books are a part of the social fabric of the charitable community and allow donors to be recognized for their contributions" (specification, page 2, paragraph bridging pages 1 and 2). In addition, "the 'advertiser's primary economic motivation is to make a contribution to the organization as opposed to receiving quality or value for a purchase" (specification, page 2, paragraph bridging pages 1 and 2). As such, the term "ad-book" has a special meaning in the context of fund-raising that should be given effect in the context of the claims.

In addition, the term "advertisement" is not inherent to the commercial arts. In this regard, Webster's New Third International Dictionary defines "advertisement" in terms of calling attention to or making known.

In this context, an "ad" or message may include, but not be limited to, a contribution from a member of the organization, or one directly or indirectly solicited by the organization or a member of the organization, a patron, supplier, vendor, guest, recipient, sponsor, honoree, alumni, past member, past advertiser, or member of some affinity group or some organization with some reasonable relationship, other than strictly wishing to advertise for the sole commercial purpose of commercial advantage and paying commercially typical advertising rates based on the

typical arms-length value of circulation. As such, an advertisement has a different meaning in this context. In this context, an "ad" or message may include, but not be limited to, a congratulatory message, an announcement, a memorial, a statement, notation or indication of support or sponsorship of the organization, a contribution, a simple advertisement or logo, a personal advertisement which may also include such person's corporate or professional identity, a corporate matching-ad or matching-gift which may further entitle the organization to additional funding, the simple listing of one's name, where the "ad" or message is most often grouped or ranked by the value of the contribution or at what giving level or for what chapter, lodge number, division, committee or affiliation to the organization, but which may include simple contact information such as name, phone, e-mail, profession, and company in an organizations directory (which may or may not be incorporated in the ad-book)

In contrast, Rothstein is directed to a commercial advertising website where "Revenue is collected from the advertisers, and the publisher is compensated, based upon the number of customers to which the enhanced electronic book is sent" (Rothstein, par. [0025]). Since the Rothstein publisher is compensated based upon the number of customers who receive the electronic book, Rothstein does not involve fund-raising or contributions in the context of non-profit organizations.

Further, the Rothstein "electronic book is received by the distributor with no space reserved for ads" (Rothstein, par. [0041]). Since the Rothstein electronic book is received without space reserved for ads, the Rothstein

electronic book is clearly intended for a different purpose than the claimed ad-books.

In contrast, the claimed ad-book is intended primarily as a list of contributors, who are contacted from individuals within the organization and who receive community recognition for their contributions and who, incidentally, may also receive commercial advantage as a secondary benefit of their contributions. As would be recognized by those of skill in the art, other members of the organization may patronize contributors, not because of their ads; but, instead, because of their contributions. In general, the advertisements of an ad-book would most often include acknowledgements, congratulations, or expressions of support or solidarity.

Since ad-books are used by not-for-profit and political organizations, ad-books are structurally different than commercial advertisements. Ad-books are structurally different because they are not intended to attract attention or convey some commercial message. This is true both for hard-copy versions of ad-books and for on-line versions. In either case, the objective is recognition of the entity, not sale of a commercial product provided by the entity.

Since Rothstein is directed to a commercial advertising site that creates electronic books, Rothstein does not do the same or any similar thing as that of the claimed invention. Since Rothstein does not do the same or any similar thing as that of the claimed invention, the rejections are improper and should be withdrawn.

Claims 1-9, 12-15, 16-37, 40-49 and 50-58 have been rejected under 35 U.S.C. §102(e) as being anticipated by

U.S. Pat. No. 6,401,075 to Mason et al. The applicant respectfully traverses these rejections.

It may be noted that Mason et al. is also directed to commercial advertising, albeit through an online newspaper. In this regard, the Mason et al. "invention provides the ability to monitor the success of particular advertising campaign in real time and facilitates the modification of an advertising campaign" (Mason et al., col. 6, lines 30-33). In addition, the Mason et al. "invention also facilitates the billing of an advertiser . . . For example, a national advertiser can purchase advertising space . . . by the number of hits the ad receives or by the number of click-throughs" (Mason et al., col. 5, lines 4-9). Since the Mason et al. GNI facilitates advertising campaigns and charges on the success of those campaigns, Mason et al. does not involve fund-raising or contributions in the context of non-profit organizations.

Further, the Mason et al. online newspaper has a value to the public that is independent of the ads and is clearly intended for a different purpose than the claimed ad-books.

In contrast, the claimed ad-book is intended primarily as a list of contributors, who receive community recognition for their contributions and who may also receive commercial advantage as a secondary benefit of their contributions. As would be recognized by those of skill in the art, other members of the organization may patronize contributors, not because of their ads; but, instead, because of their contributions.

Since Mason et al. is directed to a commercial advertising site that creates electronic books, Mason et al. does not do the same or any similar thing as that of the claimed invention. Since Mason et al. does not do the

same or any similar thing as that of the claimed invention, the rejections are improper and should be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 10-11 and 38-39 have been rejected under 35 U.S.C. §103(a) as being obvious over Rothstein. The applicant respectfully traverses these rejections.

In this regard, the Examiner apparently relies upon "Official Notice" as a basis for the assertion that it would have been obvious to install a firewall on the Rothstein web server 220. However, the Examiner fails to provide any basis for this contention.

However, it is believed that the use of firewalls in servers for commercial advertising is an entirely different application than that of the claimed invention and that it would not be obvious to use a firewall with a server that assembles ad-books of lists of contributors to organizations. Therefore, it is respectfully requested that the Examiner provide a reference that establishes the obviousness of this missing element or withdraw the rejections.


Closing Remarks

Allowance of claims 1-58, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application

under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed.

Respectfully submitted,
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